

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Raphael Mechoulam; Natalya M.  
Kogan; Ruth Rabinowitz; and,  
Michael Schlesinger  
Group Art Unit:  
Serial No.: 10/597166  
Confirmation No.: 7062  
Filed: July 13, 2006  
For: THERAPEUTIC USE OF  
QUINONOID DERIVATIVES OF  
CANNABINOID

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir,

RESPONSE TO NOTICE TO FILE MISSING  
REQUIREMENTS UNDER 35 U.S.C. 371 IN THE DO/EO/US

This is in response to the Notice to File Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US), mailed July 21, 2008.

Applicants submit herewith a copy of the Notice to File Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US).

Applicants respectfully request that the subject Notification of Missing Requirements be withdrawn for the following reasons:

1. Applicants suggest that the proper fees were timely paid with the filing of the present application in view of the new claim set that was part of the originally filed Section 371 specification. A copy of the claim set intended to be examined appears as a part of the PAIR file history for the subject application. The claim set intended to be examined consists of 41 total claims and no multiple dependent claims. In accordance with M.P.E.P. Section 714.01(e), “Amendments Before First Office Action”:

“Applicants should note, however, that **there is no need to file a preliminary amendment to the claims on filing**. By making the new claim set part of the originally filed specification, applicant may avoid having to pay an application size fee, as both the specification (including the claims) and any preliminary amendment are used in counting the number of pages for purposes of 37 CFR 1.16(s). **The claim set submitted should be the set of claims intended to be examined**, and when the claims submitted on filing are part of the specification (on sequentially numbered pages of the specification (see 37 CFR 1.52(b)(5))), no status identifiers and no markings showing the changes need to be used.” M.P.E.P. Section 714.01(e) [Emphasis Added]

Further, M.P.E.P. Section 506, “Completeness of Original Application,” pronounces a general principle adopted by the Office regarding Preliminary Amendments at least for filing of non-provisional applications under 37 CFR 1.53(b):

“Therefore, **the Office strongly recommends that applicants file their applications with a specification containing only the desired set of claims**, rather than filing the application with a preliminary amendment canceling claims.” M.P.E.P. Section 506 [Emphasis Added]

It appears from the form PTO 1360, "Multiple Dependent Claim Fee Calculation Sheet," which is a part of the subject file history, calculated fees on a claim set other than the one that was submitted with the copy of the specification originally filed with the Section 371 application.

Therefore, Applicants suggest that a Preliminary Amendment is not required in the present application and that the set of claims consisting of 41 total claims, which set is found in the papers of the present application along with the substitute specification, be used for fee calculation purposes. Accordingly, Applicants request that the request for additional claim fees in the Notification of Missing Requirements be withdrawn.

2. Regarding the asserted defective oath or declaration that was filed with the papers of the present application, Applicants used the form PTO/SB/01A promulgated by the Office when an Application Data Sheet is used. A copy of the Application Data Sheet appears as a part of the PAIR file history for the subject application. Therefore, Applicants suggest that the proper form PTO/SB/01A for the oath or declaration has been filed in the subject application. Accordingly, Applicants request that the objection to the form of the oath or declaration in the Notification of Missing Requirements be withdrawn.

3. Finally, the Notification of Missing Requirements states in two bulleted sub-paragraphs on page 2 of 3 that Applicants must submit both a paper copy and computer readable Sequence Listings. In accordance with M.P.E.P. Section 2421.02, "Summary of the Requirements of the Sequence Rules," Applicants suggest that the Sequence Rules should not apply to the subject application.

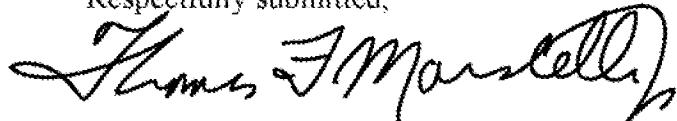
Specifically, M.P.E.P. Section 2421.02 states:

The sequence rules embrace all unbranched nucleotide sequences with ten or more bases and all unbranched, non-D amino acid sequences with four or more amino acids, provided that there are at least 4 "specifically defined" nucleotides or amino acids. The rules apply to all sequences in a given application, whether claimed or not. All such sequences are relevant for the purposes of building a comprehensive database and properly assessing prior art. It is therefore essential that all sequences, whether only disclosed or also claimed, be included in the database." M.P.E.P. Section 2421.02 [Emphasis Added]

Accordingly, Applicants suggest that the subject application does not qualify under the Sequence Rules as requiring a sequence listing. Therefore, Applicants request that the request for the submission of Sequence Listings in the Notification of Missing Requirements be withdrawn.

In conclusion, Applicants request that the Notification of Missing Requirements be withdrawn in its entirety in accordance with the above states reasons and that the application be passed on to the examination phase.

Respectfully submitted,



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